

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT GERALD ALLAM,
MARK TODD BROUSSARD,
CAROLE GRACE SAYLOR
and GARY CHARLES STAAS

Appeal 2007-1892
Application 09/738,598¹
Technology Center 2100

Decided: December 13, 2007

Before ALLEN R. MACDONALD, JAY P. LUCAS, and MARC S. HOFF,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-58. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Application filed December 15, 2000. The real party in interest is bytesizebooks.com.

Appellants' invention relates to method and apparatus for displaying and viewing electronic information for uses such as electronic books and electronic coursebooks (Specification 1). In one embodiment, an electronic image of a page of the book is displayed in one window of a computer screen, with a box bounding certain text. That text is also displayed in a second window of the computer screen, possibly with pertinent annotations (Specification 11-12).

Claim 1 is exemplary:

1. A method for viewing electronic information comprising the steps of:

displaying in a first window a physical page from an electronic document containing information from a predefined page format, wherein the electronic document comprises representations of at least one physical page, and a visual reference disposed on the physical page in the first window that identifies information on a portion of the at least one physical page,

extracting the information identified by the visual reference on the at least one physical page, and

presenting the extracted information in a second window wherein the extracted information is free flowing which means sentences and paragraphs of the extracted information flow without interruption in the second window and any line break of the extracted information is handled dynamically depending upon a column width of the second window.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|----------------|-----------|---------------|
| Reed | 5,241,671 | Aug. 31, 1993 |
| Rivette ('079) | 5,806,079 | Sep. 8, 1998 |
| Rivette ('749) | 6,018,749 | Jan. 25, 2000 |

Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rivette '749.

Claims 5, 19, 20, 29 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette '749 in view of Rivette '079.

Claims 39-41 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette '749 in view of Rivette '079 and Reed.

Claim 54 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette '749.

Claims 1-10, 29, 44, 46-51 and 57 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 and 20 of copending Application No. 10/691,927 in view of Rivette '079.²

Appellants contend that the Examiner erred in his rejections because a window that surrounds text is by definition not a visual reference disposed on the physical page in a first window (Br. 10). The Examiner contends the claims are properly rejected because the borders of a window constitute a visual marking, which is disposed "on," i.e. within, the physical page (Ans. 12).

² The provisional double patenting rejection is not before the Board. We also note that copending Application No. 10/691,927 is now abandoned.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Rivette '749 teaches a visual reference, disposed on a physical page in a first window, that identifies information on a portion of the at least one physical page.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, they have invented a method and apparatus for displaying and viewing electronic information for uses such as electronic books and electronic coursebooks (Specification 1).
2. In one embodiment, an electronic image of a page of the book is displayed in one window of a computer screen, with a box bounding certain text. That text is also displayed in a second window of the computer screen, possibly with pertinent annotations (Fig. 3; Specification 11-12).

Rivette '749

3. Rivette '749 teaches a method and apparatus for extracting, synchronizing, displaying, and manipulating text and image documents in machine readable form for display (col. 3, ll. 30-33).

4. Rivette '749 teaches an interface in which one window shows an image of the document, and another window contains the text from the document, which has been processed such that the user may easily read it, search by keyword, etc. (see Figs. 30, 59).

5. Rivette teaches extracting the entire content of PTO Text and PTO Image files and converting them for use by its processing system, which synchronizes and indexes the files. This includes producing an "Equivalent File" which may be displayed and manipulated (col. 19, l. 65 – col. 21, l. 11).

6. The contents of the text window (the "Equivalent File") may be synchronized with the image file, meaning that the text window may be set to display the exact same text shown in the image window (col. 4, ll. 5-10).

7. The image shown on the right in Fig. 59 is only a portion of the physical page (Ans. 3).

8. Rivette '749 discusses and illustrates patent documents as examples, but contemplates that his invention is applicable to documents of every type, and is not limited to patent documents (col. 14, ll. 39-42).

Rivette '079

9. Rivette '079 teaches a system and method of linking notes to data objects. The invention enables a user to select a portion of a data object associated with an application. The invention creates a sub-note in a note, and links the sub-note to the selected portion. The invention receives a request from a user viewing the note to display the selected portion linked to the sub-note. In response to this request, the invention invokes the application, if the application is not already invoked, and causes the application to load the data object and present the selected portion (col. 3, l. 60 – col. 4, l. 3).

10. Rivette '079 states that hyperlinks are a conventional mechanism to accomplish the association of data objects with each other. In some applications, there is a need for a mechanism that organizes, associates, and links data objects, and also conveys contextual information explaining the rationale for such organization, association, and linkage (col. 1, ll. 43-47; col. 2, ll. 36-41).

Reed

11. Reed teaches a search system in which a multimedia database consisting of text, picture, audio, and animated data is searched through multiple graphical and textual entry paths.

12. Reed teaches examining extracted information for unfamiliar words and displaying definitions for the unfamiliar words (col. 14, ll. 28-40).

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Piasecki*, 745 F.2d at 1472. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

The determination of obviousness must consider, *inter alia*, whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124 (Fed. Cir. 2000). *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006). Where the teachings of two or more prior art references conflict, the

examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Further, our reviewing court has held that:

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *Para-Ordnance Mfg. v. SGS Importers Int’l*, 73 F.3d 1085, 1090 (Fed. Cir. 1995), *cert. denied*, 117 S. Ct. 80 (1996).

As was recently described in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006):

[T]he “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness. (internal citations omitted).

Id. at 988. To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. *See id.* at 987-88 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”). ““The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”” *Id.* at 987-88 (quoting *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)).

ANALYSIS

Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58

Appellants argue that the Examiner erred in rejecting claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 as being anticipated by Rivette ‘749 because Rivette fails to provide ““a visual reference disposed on the physical page in the first window that identifies information on a portion of the at least one physical page”” (Br. 9), as required by claim 1. Appellants argue that the Examiner’s interpretation of Rivette ‘749, in which “[t]he window surrounding the text is the visual reference, which is disposed on the physical page” is erroneous, because “by definition” a window that surrounds text is not a visual reference disposed on the physical page in the first window (Br. 10). We agree with the Examiner. Rivette ‘749 teaches an interface in which one window shows an image of the document (“the physical page”), and another window containing the text from the document, which has been processed such that the user may easily read it, search by

keyword, etc (FF 4). The Examiner points out that the image shown on the right in Rivette '749 (Fig. 59) is only a portion of the physical page (Ans. 3; FF 7). As such, we agree with the Examiner that the image window of Rivette '749 constitutes a "visual reference" "disposed" on the physical page.

Appellants further argue that “the Examiner’s visual reference clearly fails to identify information within a first window, on a physical page, that is to be displayed within a second window” (Br. 10). Appellants’ argument is inapposite. First, as noted by the Examiner, the claimed invention does not contain this limitation. Second, Rivette ‘749 discloses that the contents of the text window on the left (the “Equivalent File”) may be synchronized with the image file, meaning that the text window may be set to display the exact same text shown in the image window (FF 6).

Appellants further argue that “extraction” in Rivette ‘749, in which a full document is converted for use by the processing system which synchronizes and indexes files, is “clearly different” from the extraction done in Appellants’ invention, in which text within the “visual reference” is displayed in a second window (Br. 11; FF 5). This argument is also inapposite. Because Rivette ‘749 extracts all the information contained in the document, Rivette ‘749 meets the claim limitation of “extracting the information identified by the visual reference on the at least one physical page.” That Rivette ‘749 extracts more information than the claim requires does not mean that Rivette ‘749 fails to anticipate the claimed invention.

Appellants further argue that Rivette ‘749 is directed to a different invention and solves a different problem than that of the claimed invention (Br. 11); that because the text in Rivette’s image window is the same size as or larger than the text in the text window, Rivette ‘749 would not have any need for a visual reference (Br. 12); and that since Rivette ‘749 enlarges the image data, Rivette ‘749 would have no reason to use a visual reference, and thus in effect teaches away from the claimed invention (Br. 12). None of these arguments are germane to the question of whether Rivette ‘749 anticipates the claimed invention under 35 U.S.C. § 102.

As a result, we affirm the rejection of claims 1, 44, 46, and 57, as well as claims 2-4, 6-18, 21-28, 30-38, 42, 43, 45, 47, 49-52, 55, 56, and 58, dependent therefrom and not separately argued.

Claims 5, 19, 20, 29 and 48

Appellants present the same argument as for claim 1, adding that Rivette ‘079 fails to supply the teaching of the use of a visual reference, allegedly missing from Rivette ‘749 (Br. 13). Because we find *supra* that Rivette ‘749 does teach a visual reference, we are not persuaded by Appellants’ argument.

In Section E of his arguments, without making specific reference to claims 5, 19, 20, 29 and 48, Appellants suggest that Rivette ‘079 refers to hyperlinks as an “undesirable alternative,” and that therefore there would be no reason to combine the teachings of Rivette ‘079 with those of Rivette ‘749 (Br. 16).

We disagree with Appellants' unsupported argument. Rivette '079 states that it is desirable to organize information such that data objects are associated with other data objects that are related to the same topic, and that hyperlinks represent a conventional mechanism to accomplish that association (FF 10). Rivette '079 goes on to express a need, in some applications, for a mechanism that organizes, associates, and links data objects, and also conveys contextual information explaining the rationale for such organization, association and linkage (*id.*). We therefore find that Rivette '079 does not characterize hyperlinks as "undesirable." We further find that the person of ordinary skill in the art, upon reading Rivette '079, would not have been led in a direction divergent from that of Appellants, because it is clear that such contextual information is not necessary in every application in which data objects are linked. As a result, we find that Rivette '079 does not teach away from the use of hyperlinks. We therefore affirm the rejection of claims 5, 19, 20, 29, and 48.

Claims 39-41 and 53

Appellants present the same argument as for claim 1, adding that Reed fails to supply the teaching of the use of a visual reference, allegedly missing from Rivette '749 (Br. 13). Because we find *supra* that Rivette '749 does teach a visual reference, we are not persuaded by Appellants' argument.

In Section E of his arguments, without making specific reference to claims 39-41 and 53, Appellants argue that because Rivette '749 is described as a system for locating information rather than a system for reading or understanding documents, there would have been no reason to modify Rivette '749 to include the dictionary taught by Reed (Br. 16).

We disagree with Appellants. Motivation to combine the references need not be found within Rivette ‘749; it may be found in Reed, or in the prior art as a whole (see *In re Kahn, supra*). We agree with the Examiner that the inclusion of a dictionary, as taught by Reed, would have been desirable because it would allow the user to look up unknown words (FF 12; Ans. 11). We therefore affirm the rejection of claims 39-41 and 53.

Claim 54

Appellants present the same argument as for claim 1, that Rivette ‘749 fails to supply the teaching of the use of a visual reference (Br. 14). Because we find *supra* that Rivette ‘749 does teach a visual reference, we are not persuaded by Appellants’ argument.

In Section E of his arguments, without making specific reference to claims 54, Appellants argue that because Rivette ‘749 is directed to displaying patents or contracts, which are “creations that are not usually subject to restrictions on copying ... there would be no need or incentive to combine the concept of a lock [to prevent unauthorized copying] with the Rivette ‘749 patent” (Br. 16-17). We agree with the Examiner that this argument is unpersuasive, because Rivette ‘749 does not limit its application to patent documents, but contemplates all documents in general (FF 8). We therefore affirm the rejection of claim 54.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-58. Claims 1-58 are not patentable.

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DECISION

The Examiner's rejection of claims 1-58 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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